

REMARKS

A. Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the amendments to the claims and the following remarks.

B. The Invention

The present invention is directed to a method and apparatus for providing service and product discounts from a supplier directly to a consumer. In one of the novel aspects of the invention, a vehicle for multiple discounts is issued by a supplier and transmitted directly to select consumers based on collected statistical data.

While the statistical data is initially used to identify a valued consumer, the discount vehicle itself is principally responsible for maintaining and reinforcing a strong and lasting relationship between the supplier and the consumer. Thus, the present invention provides a method and apparatus for the supplier to foster a

relationship directly with the consumer, thereby bypassing traditional newspaper coupon methods or the like typically used to provide discounts on a mass scale.

C. Status of the Claims

Claims 1-3, 5-20 and 22-25 are pending in this Application, claims 4 and 21 having been cancelled by this amendment.

Claim 14 has been amended to recite that the supplier sends the value card to a selected retail consumer. The language specifying that the value card is sent "based on said sale data" has been deleted.

D. Rejection under 35 USC 101

Claims 20-25 have been rejected as being directed to non-statutory subject matter. The Examiner has taken the position that the claimed coupon kit is non-statutory since the claimed coupon kit could be interpreted as a set of paper coupons which would require a recitation of specific hardware used to read the coupon kit.

Applicants respectfully disagree with the Examiner's position, as it is generally understood that coupons contain bar code indicia or the like that store detailed

information used to identify the coupon as it is scanned or otherwise read. In addition, a review of the pertinent statutory sections has confirmed that there is no requirement to positively claim any specific hardware or devices that are capable of reading the coupons.

Furthermore, dependent claims 21-25 do not introduce any limitations that would require the recitation of specific hardware in claim 20. Claim 20 merely recites the coupon kit itself, including the limitation that the coupon kit is issued by the supplier. No further hardware or devices are deemed necessary to meet the statutory requirements. Reconsideration of this rejection is therefore respectfully requested.

E. Rejection of Claims 4, 14 and 21 under 35 USC 112

Claim 14 has been rejected as being indefinite for reciting that the value card is sent to the selected retail customer based on sale data. Applicants have deleted the language "based on said sale data" in order to simply recite that the value card is sent to selected retail customers.

Claims 4 and 21 have been cancelled. The objection to these claims is now moot.

F. Rejections under 35 USC 103(a)

Claims 1-10 and 13-19 have been rejected as being unpatentable over Fajkowski in view of the cited marketing scheme entitled "Identify Opportunities to Build Shares".

Initially, Applicants wish to summarize the Examiner's comments on pages 4-7 of the Office Action concerning the previously submitted arguments concerning the above rejection.

First, at page 4, the Examiner admits that Fajkowski does not explicitly teach a system wherein the manufacturer directly issues or sends the coupon card to the consumer (page 4, lines 9-11). The Examiner then takes the position that:

- A) the cited article describes a well-known marketing promotion scheme wherein a coupon is issued to consumers to encourage repeat purchasing (page 4, line 12 to page 5, line 6);
- B) directly issuing a coupon from a supplier or a third party to a consumer is an obvious matter of choice or desires that does not directly impact the issuance of coupons (page 5, lines 7-14, and page 6, lines 5-15); and

C) Applicants do not set forth any convincing arguments to show a critical difference between having the supplier versus having the third party issue the coupons (page 6, lines 15-20).

Applicants respectfully disagree with the Examiner's position in each of A-C above.

1. The cited article does not describe a marketing scheme wherein a supplier or a third party directly issues coupons to the consumer

Paragraphs 2 and 5 of the cited article refer to a method used to "Target Competitive Users" and "Maintain Gains Over Long Term".

As described in paragraph 2, a Checkout coupon program is run whereby an initial Checkout coupon is issued to shoppers as they buy a specified brand at a retail establishment. When the initial Checkout coupon is redeemed (at a future Checkout), a subsequent coupon is issued to encourage repeated purchasing.

Paragraph 5 explains that the retailer's check cashing or ATM system is used to track purchase behavior thereby allowing a coupon to be initially issued, for example, on the fourth shopping trip to be redeemable on the fifth.

The cited article differs from the present invention because the article explains that the coupons are issued during an initial Checkout at a retail establishment. Since the coupons are issued at Checkout, the customer must already have shopped, selected products and proceeded to checkout, prior to the issuance of the first coupon.

The timing and parties involved in the cited marketing scheme therefore drastically differ from the present invention. The article explains that coupons are issued at the Checkout register of a retail establishment. In contrast to this arrangement, the present invention does not involve a retail establishment, since coupons are issued directly from the supplier to the consumer.

Respectfully, it cannot be said that the cited article teaches or suggests the direct issuance of a coupon from the supplier or a third party to the consumer without the intervention of a retail establishment as disclosed in the present invention.

2. Items B and C above

The Examiner has taken the position that having a supplier sending, rather than a coupon card service provider or clearinghouse, a coupon to a registered

customer is a matter of choice or convenience that does not directly impact the issuance or redemption of coupons.

As explained above, the cited article does not teach the direct issuance of a coupon from a supplier to a consumer, irrespective of whether the issuance involves a third party working in conjunction with the supplier. The key aspect of the present invention is the fact that the supplier can achieve direct contact with the ultimate consumer, without the unnecessary intervention of retail establishments, newspapers or the like.

The cited article fails to disclose the essential teaching of the present invention, namely, the direct issuance of a coupon from a supplier or a related party to a consumer. It is therefore respectfully submitted that the present invention is patentable over Fajkowski in view of the cited article.

G. Rejections under 35 USC 102(b) based on Valencia

Claims 1-12 and 14-25 have been rejected as being anticipated by Valencia. The Examiner has stated that Valencia teaches a system whereby a customer is given a coupon card at a retail establishment. The Examiner has broadly interpreted Valencia to teach that the manufacturer

or supplier provides the coupons to the consumer (page 7, lines 7-15).

1. A broad reading of Valencia does not teach that the supplier "issues" the coupons as this term is used in the present invention

As stated by the Examiner, Valencia teaches that the coupon card is presented to a customer at a POS of a retail establishment. Respectfully, it is the retail establishment that "issues" the coupon card to the consumer, not the supplier.

Applicants respectfully submit that the Examiner's broad reading of Valencia is not warranted under the circumstances. The supplier of Valencia "issues" the coupon card to the retail establishment. In contrast, the supplier of the present invention "issues" the coupons to the consumer.

It is readily apparent from a reading of the application that the term "issues" as used throughout the specification and the claims refers to a communication between the supplier and the consumer, without the intervention of the retail establishment. Thus, Applicants respectfully disagree with the Examiner's broad reading of

the word "issues" under the circumstances. Reconsideration and removal of the rejection is requested.

H. Rejections under 35 USC 102(b) based on Fajkowski

Claims 20-25 have been rejected as being anticipated by Fajkowski. The Examiner has taken the position that Fajkowski teaches a system whereby a customer is given a coupon card at a POS of a retail establishment. This rejection is substantially identical to the rejection under 102(b) based on Valencia in section G above.

Similar to Applicants comments concerning Valencia, Fajkowski fails to teach the direct issuance of coupons from a supplier to a consumer without the intervention of a retail establishment. Applicants direct the Examiner to the previous arguments concerning the teachings of Fajkowski in section F above and the arguments concerning the teachings of Valencia in section G above.

It is respectfully submitted that Fajkowski does not teach the direct issuance of coupons from a supplier to a consumer as claimed in the present invention.

I. Extension of Time

Applicants note that the 4-month statutory period for response is set to expire on Sunday, November 21, 2004. As this date falls on a weekend, the 4-month period for response is extended until Monday, November 22, 2004.

This response is therefore being filed within the 4-month statutory period. A one-month extension of time is hereby requested and PTO Form 2038 is enclosed for the appropriate fee.

J. Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested.

Should any further fees be necessary in order to maintain this Application in pending condition, appropriate

requests are hereby made and authorization is given to
debit Account # 02-2275.

Respectfully submitted,

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Encl: Fee Transmittal Form
PTO Form 2038